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Patent
Case No.: 59001US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: WOLK, MARTIN B.

Application No.: 10/731199

Group Art Unit: 1752

Filed: December 9, 2003

Examiner: Richard L. Schilling

Title: THERMAL TRANSFER OF LIGHT-EMITTING DENDRIMERS

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR § 1.8(a))

I hereby certify that this correspondence is being:

- ☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- ☒ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at 571-273-8300.

FEB 14 2006

Date

Signed by:

Dear Sir:

Claims 1-17 were rejected under 35 U.S.C. § 103 as being unpatentable over International Publication 99/219935 or Vitukhnovsky et al. both in view of International Publication WO 2003/017731 to Bellman et al. The Bellman et al. reference was cited as prior art under 35 U.S.C. § 102(a). Applicant files herewith an Affidavit Under 37 C.F.R. § 1.31 to swear behind the publication date (February 27, 2003) of the Bellman et al. reference to remove it as prior art. See MPEP § 715 (stating that 131 affidavits may be used "[t]o antedate a reference or activity that qualifies as prior art under 35 U.S.C. 102(a) and not under 35 U.S.C. 102(b)"). Bellman et al. does not qualify as prior art under 35 U.S.C. § 102(b) in that it was published less than one year before Applicant's priority date. As recited in the Affidavit and accompanying Lab Notebook pages, Applicant achieved conception and reduction to practice of the present invention prior to February 27, 2003 and, therefore, Bellman et al. does not qualify as prior art under 35 U.S.C. § 102(a). With Bellman et al. removed as prior art, Applicant respectfully submits that claims 1-17 are patentable for at least the reason that the cited references do not disclose or suggest thermal transfer of dendrimers.

Claims 1-17 were rejected for obviousness-type double patenting as being unpatentable over claims 1-17 of US Patent No. 6,844,128 to Hsu et al. in view of International Publication

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99/219935 and Vitukhnovsky et al. Applicant files herewith a Terminal Disclaimer to overcome this double patenting rejection.

Based upon the above remarks and documents filed herewith, Applicant respectfully submits that claims 1-17 are patentable. Reconsideration and allowance of all pending claims are respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

Respectfully submitted,

February 14, 2006

Date

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